

REMARK/ARGUMENTS

Claims 1-2 and 4-20 are pending in this application. Applicant has carefully reviewed the Office Action and feel the case is in condition for allowance in view of the amendments and remarks made below.

CLAIM OBJECTIONS

Claim 12 is objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form. Applicant cancels claim 12 obviating the objection with respect to claim 12.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1, 2, 4, 7, 8, 11, 15 and 18-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by Young. While the Examiner refers to the prior art reference as “Young,” the Examiner does not give the patent number of this reference. Applicant therefore assumes the Examiner is referring to U.S. Patent No. 2,549,741 to T.R. Young, entitled “Pipe Joint,” filed February 6, 1948. Applicant further assumes that while the Examiner stated the claims rejection under 35 U.S.C. § 102(e), the Examiner meant to reject the claims under 35 U.S.C. § 102(b), and will base the Applicant’s remarks on these two assumptions. The Applicant respectfully traverses these rejections.

The Section 102 rejection is proper only if each and every element, as set forth in the claim, is found – i.e., the prior art must teach every aspect of the claim. *See Verdegall Bros. v. Union Oil Co. of California*, 918 F.2d 628, 631 (Fed. Cir. 1987); *see also* M.P.E.P. § 2131. Young does not teach or suggest the combination recited by the claims. For example, claim 1, and its dependent claims 2 and 4-10, recite, “a second chamber contained within the housing and configured to allow an end of a pipe to slide through it and to provide a bridge for material flowing from the pipe to a second pipe where the end of the pipe does not contact the end of the second pipe.” The Examiner asserts, on page 2 of the Office Action, that the second chamber, as described in the claim, is shown in Young by reference numeral 17. However, the chamber

identified by reference numeral 17 in Young, is not the chamber as recited by independent claim 1 and its dependent claims. Reference numeral 17 is an annular groove in which a split ring 18 sits. See FIG. 4 and also column 3, lines 16, 31. The groove 17 is not a second chamber contained within the housing and configured to allow an end of a pipe to slide through it and to provide a bridge for material flowing from the pipe to a second pipe when an end of the pipe does not contact the end of the second pipe. In fact, there is no teaching or suggestion in Young that material is bridged from one pipe to the other through groove 17. In fact, the split ring is designed to hinder movement of material. At least for this reason, Applicant respectfully requests that the rejection under Section 102 be removed with respect to claim 1 and its dependent claims 2 and 4-10.

With respect to independent claim 11, and its dependent claims 13-17, Young does not teach or suggest a combination recited by claim 11 and its dependent claims. For example, claim 11, and its dependent claims, recite in part, “means for bridging fluid flowing from the pipe to the second pipe when an end of the pipe does not contact an end of the second pipe. The Examiner, on page 3 of the Office Action, asserted that Young teaches the means quoted above as indicated by item 17 in FIG. 4 on page 3 of the Office Action. However, as stated above, item 17 of FIG. 4 is an annular groove and does not provide a means for bridging fluid flowing from the pipe to the second pipe when an end of the pipe does not contact an end of the second pipe. Therefore, Applicant respectfully requests that the rejection of claims 11 and 13-17 be removed under 35 U.S.C. § 102 as being anticipated by Young.

With respect to claims 18 and 20, Young does not teach or suggest a method including “bridging material carried by the pipe with the slip joint adapter between two non-contacting pipe ends,” as recited by claim 18. On page 4 of the Office Action, the Examiner characterizes the spigot member 12 to be the second pipe, and the first pipe to be item 11. Under the Examiner’s theory of the spigot member, 12 being the second pipe, and the first pipe being item 11, Young does not teach or suggest the method recited by claim 18 because, for example,

two pipe ends, 12 and 11, contact each other, whereas, the claim recites two noncontacting pipe ends. In FIGS. 1, 3 and 4, the two pipe ends contact each other as pipe 12 slips into the inner diameter of pipe 11 forming a fit between the two pipe ends. Because Young does not teach or suggest the method recited by claim 18 and its dependent claims 19 and 20, Applicant respectfully requests that the rejection of claims 18-20, under 35 U.S.C. § 102 in view of Young, be removed.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-2, 4-7 and 9-14 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.* Applicant respectfully traverses this rejections.

To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion or motivation, either in the references, themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. § 2142.

With respect to claims 1-2, 4-7 and 9-10, *Rubin, et al.* in view of *Hampe, et al.* does not teach or suggest the combination recited by the claims. For example, claim 1, and, thus, its dependent claims, recites, “a second chamber contained within the housing and configured to allow an end of a pipe to slide through it and to provide a bridge for material flowing from the pipe to a second pipe, when an end of the pipe does not contact an end of the second pipe.” As shown in FIG. 5 of *Rubin, et al.*, the two pipes do not contact each other as 80 is a reduced-diameter section which fits inside of pipe 24. See also column 5, lines 52-58. Thus, *Rubin, et al.* does not teach or suggest a second chamber providing a bridge for a material. In fact, *Rubin, et al.* teaches a way from using the adaptor to a rider bridge by discussing an alternative means of

transferring material from one pipe to the other by having the reduced-diameter section fit inside the other pipe, thus obviating a need for a bridge. Thus, Applicant respectfully requests the Examiner to remove the rejection of claims 1, 2, 4-7, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.* With respect to claims 11-14 and 16-17, again the prior art references cited do not teach or suggest the combination recited in the claims. For example, claim 1 recites, “means for bridging fluid flowing from the pipe to the second pipe when an end of the pipe does not contact an end of the second pipe.” As described above, *Rubin, et al.* uses two pipe ends in connection with each other whereas one pipe has a reduced diameter and fits inside the other pipe. Therefore, *Rubin, et al.* teaches a way from the apparatus described in independent claim 11 and its dependent claims. Therefore, Applicant respectfully requests that the Examiner remove the rejection of claims 11-14 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.*

With respect to claim 18 and its dependent claim 19, the prior art references do not teach or suggest a method as recited by these claims. For example, claim 18 recites, “a method, including, among other things, bridging material carried by the pipe with a slip joint adaptor between two non-contacting pipe ends.” As described above, *Rubin, et al.* teaches two pipe ends not only contacting, but one fitting inside the other, and, thus, teaches a way from using the subjoint adaptor, itself, to bridge the material carried between the two pipes. Therefore, Applicant respectfully requests the Examiner to remove the rejections under 35 U.S.C. § 103(a) as being unpatentable over *Rubin, et al.* in view of *Hampe, et al.*

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests objections and rejections be removed and the pending claims allowed. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1792 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not time filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036.

Respectfully submitted,

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